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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,808	08/17/2001	Gregory Fx Iannacci	GFX-113	5862
30212	7590	09/22/2006	EXAMINER	
GREGORY FX IANNACCI 30 KEENE STREET STONEHAM, MA 02180			LIVERSEDGE, JENNIFER L	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/932,808	IANNACCI, GREGORY FX	
	Examiner	Art Unit	
	Jennifer Liversedge	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/17/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

Page 36, line 8 should refer to "airline miles" rather than "airline mles".

Page 89, line 19 should include a space between "identification" and "codes".

Page 93, line 21 should include a space between "pointers" and "to".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Computer software is not allowable subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4, 6-11 and 13-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Patent No. 5,477,040 to Lalonde (further referred to as Lalonde).

Regarding claim 1, Lalonde discloses a method for use in the acquisition of economic and personal benefits, said method employing computer means having data storage means and network communications means (Figure 1) and comprising the steps of:

(a) receiving a request to produce a benefit-driven settlement solution for an identified user having ranked benefit preferences (column 1, lines 8-20; column 3, lines 3-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40);

(b) conducting an electronic search to identify benefits pertinent to said request (column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40); and

(c) categorizing benefits this identified in accordance with said user's ranked benefit preferences (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40).

Regarding claim 2, Lalonde discloses the method comprising the further step of determining a settlement solution associated with at least one of said categorized

benefits (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40).

Regarding claim 4, Lalonde discloses the method comprising the further steps of evaluating said categorized benefits and determining at least one of said categorized benefits as providing said user with the benefit of highest value to said user (column 2, lines 38-43; column 3, lines 10-18; column 9, lines 31-40; column 10, lines 19-30).

Regarding claim 6, Lalonde discloses the method wherein the step of evaluating said categorized benefits is undertaken by the user upon electronic disclosure of said categorized benefits to said user (column 4, lines 14-19; column 9, lines 31-40; column 10, lines 19-30).

Regarding claim 7, Lalonde discloses the method wherein said step of determining the benefit of highest value to said user is performed automatically without user intervention (column 1, lines 5-19; column 2, lines 38-43; column 3, lines 10-36; column 4, lines 14-19 and lines 56-61; column 6, lines 53-57; column 9, lines 31-40; column 10, lines 19-30).

Regarding claim 8, Lalonde disclosed the method further comprising the steps of:

(a) identifying at least one provider of said settlement solution (Figures 1, 5 and 6); and

(b) initiating and consummating a transaction with the provider, or plurality of providers, of said settlement solution (Figures 1, 5 and 6).

Regarding claim 9, Lalonde discloses the method further comprising the step of establishing such electronic and logical linkages as may be required to enable said user to process said settlement solution and to acquire said benefits associated with said solution (Figures 1, 5 and 6).

Regarding claim 10, Lalonde discloses the method further comprising the additional steps of obtaining such accounts and of satisfying such conditions as may be required to process said settlement solution and to acquire for said user the said benefits associated with said solution (Figures 1, 5, 6 and 7).

Regarding claim 11, Lalonde discloses the method wherein said step of determining a settlement solution comprises a selection by said user from among

plurality of proposed settlement solutions transmitted electronically to said user (column 4, lines 14-19; column 9, lines 31-40; column 10, lines 19-30).

Regarding claim 13, Lalonde discloses the method further comprising the step of determining at least one benefit-driven settlement solution to a consumer payment transaction (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40).

Regarding claim 14, Lalonde discloses the method further comprising the step of electronically transmitting, to at least one payment service provider able to provide at least one of said identified benefits, such user information and such consumer transaction information as said payment service provider may require as conditions for authorizing payment of said consumer transaction and issuing said benefit to said user (Figures 1, 5, 6, 7 and 8).

Regarding claim 15, Lalonde discloses the method further comprising the step of electronically transmitting, to at least one benefit provider able to provide at least one of said identified benefits, such user information and such consumer transaction information as said benefit provider may require as conditions for issuing said benefit to said user (Figures 1, 5, 6, 7 and 8).

Regarding claim 16, Lalonde discloses the method further comprising the step of determining at least one benefit-driven settlement solution to a query from a user concerning a proposed acquisition of consumer goods or services (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40).

Regarding claim 17, Lalonde discloses the method further comprising the step of electronically disclosing to said user said at least one settlement solution responsive to said query (column 4, lines 14-19; column 9, lines 31-40; column 10, lines 19-30; Figures 1, 5 and 6).

Regarding claim 18, Lalonde discloses the method further comprising the step of transmitting electronically a consumer transaction query to at least one provider of consumer goods or services, whereby said provider is caused to commit electronically to the consummation of said transaction on terms providing for the issue of a specified identified benefit, or plurality or benefits, to said user (column 1, lines 5-28; column 2, lines 58-63; column 3, lines 20-37; column 4, lines 56-61; column 6, lines 20-59; column 8, lines 1-8; Figures 1, 5, 6, 7 and 8).

Regarding claim 19, Lalonde discloses the method further comprising the step of transmitting electronically a binding commitment from said user to consummate said proposed acquisition on specified benefit-driven terms (Figures 1, 5, 6, 7 and 8).

Regarding claim 20, Lalonde discloses the method further comprising the step of determining at least one benefit-driven settlement solution to a benefit exchange transaction between at least two identified users (column 1, lines 5-28; column 2, lines 58-63; column 3, lines 20-37; column 4, lines 56-61; column 6, lines 20-59; column 8, lines 1-8; Figures 1, 5, 6, 7 and 8).

Regarding claim 21, Lalonde discloses the method further comprising the step of electronically transmitting a benefit exchange solicitation from a first identified user to at least one other user (column 1, lines 5-28; column 2, lines 58-63; column 3, lines 20-37; column 4, lines 56-61; column 6, lines 20-59; column 8, lines 1-8; Figures 1, 5, 6, 7 and 8).

Regarding claim 22, Lalonde discloses the method further comprising the steps of:

(a) said first user receiving electronically an affirmative response to said solicitation from at least one other user (column 1, lines 5-28; column 2, lines 58-63; column 3, lines 20-37; column 4, lines 56-61; column 6, lines 20-59; column 8, lines 1-8; Figures 1, 5, 6, 7 and 8);

(b) transmitting at least one proposed benefit exchange solution between said users (column 1, lines 5-28; column 2, lines 58-63; column 3, lines 20-37; column 4, lines 56-61; column 6, lines 20-59; column 8, lines 1-8; Figures 1, 5, 6, 7 and 8); and

(c) consummating a benefit exchange transaction between said first user and at least one other user (Figures 1, 5, 6, 7 and 8).

Regarding claim 23, Lalonde discloses the method wherein said transaction is consummated employing preprogrammed instructions enabling its consummation without the transaction-specific participation of at least one user party to said transaction (column 1, lines 5-19; column 2, lines 38-43; column 3, lines 10-36; column 4, lines 14-19 and lines 56-61; column 6, lines 53-57; column 9, lines 31-40; column 10, lines 19-30).

Regarding claim 24, Lalonde discloses the method wherein said transaction is consummated employing user intervention and instructions enabling its consummation

with the transaction-specific participation of at least one user party to said transaction (column 4, lines 14-19; column 9, lines 31-40; column 10, lines 19-30).

Claims 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,945,653 to Walker et al. (further referred to as Walker).

Regarding claim 25, Walker discloses an apparatus for creating settlement solutions by establishing and executing functions that review and determine objects of value to consummate transactions (Figures 2, 5 and 7A-7C; column 3, lines 42-51; column 4, lines 12-40; column 8, lines 33-57), said apparatus comprising:

- (a) a processor (Figure 2; column 11, lines 29-65);
- (b) an input device connected to said processor (Figure 2; column 11, lines 29-65);
- (c) an output device connected to said processor (Figure 2; column 11, lines 29-65);
- (d) a clock device connected to said processor (Figure 2; column 11, lines 29-65);
- (e) a logic and control device connected to said processor (Figures 2 and 7A-7C; column 11, lines 29-65);
- (f) a memory connected to said processor storing programs to control the operation of said processor (Figure 2; column 11, lines 29-65);

(g) a communication device connected to said processor (Figure 2; column 11, lines 29-65);

(h) a data storage device connected to said processor (Figure 2; column 11, lines 29-65);

(i) the processor operative with the program in memory to:

i. record data of users, benefits, settlement solutions, and transactions (column 11, lines 36-40; Figure 2);

ii. receive requests to process transactions (column 5, lines 28-35; column 18, lines 16-22);

iii. enable information to be available to users (column 16, lines 44-50; column 18, lines 45-48);

iv. produce settlement solutions (column 19, lines 44-56);

v. process settlement solutions with and without user intervention (column 15, lines 62-67; column 18, lines 43-48; column 19, lines 44-56);

vi. transmit information to users electronically (Figure 9; column 18, lines 45-48);

vii. consummate transactions (Figures 7A-7C; Figures 8A-8B); and

viii. receive, record, and store user information and transaction activity (Figures 7A-7C; Figures 8A-8B).

Regarding claims 26 and 27, Walker discloses an apparatus and (storage medium device) for creating settlement solutions by establishing and executing

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functions that review and determine objects of value to consummate transactions (Figures 2, 5 and 7A-7C; column 3, lines 42-51; column 4, lines 12-40; column 8, lines 33-57), said apparatus comprising:

(a) means for recording data of users, benefits, settlement solutions, and transactions (column 11, lines 36-40; Figure 2);

(b) means for receiving requests to process transactions (column 5, lines 28-35; column 18, lines 16-22);

(c) means for enabling user access to information (column 16, lines 44-50; column 18, lines 45-48);

(d) means for producing settlement solutions (column 19, lines 44-56);

(e) means for processing settlement solutions (column 15, lines 62-67; column 18, lines 43-48; column 19, lines 44-56);

(f) means for transmitting information to users electronically (Figure 9; column 18, lines 45-48);

(g) means for consummating transactions (Figures 7A-7C; Figures 8A-8B); and

(h) means for receiving, recording, and storing user information and transaction activity (Figures 7A-7C; Figures 8A-8B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde and further in view of Introduction to Industrial and Systems Engineering by Turner et al., 1993 (further referred to as Turner).

Regarding claim 3, Lalonde discloses wherein user preferences are employed in determining said settlement solution (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40). Lalonde does not disclose a Pareto optimal function. However, Turner discloses a Pareto optimal function (page 228). It would be obvious to one of ordinary skill in the art to modify the card selection method as disclosed by Lalonde to adapt the teaching of a Pareto optimal function as disclosed by Turner. The motivation would be that a Pareto analysis is performed when issues of prioritization are under consideration and for the card selection process, it would be necessary to prioritize the user preferences in order to make a decision as to which card to select.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde as applied to claim 4 above, and further in view of Patent No. 5,945,653 to Walker et al. (further referred to as Walker).

Regarding claim 5, Lalonde does not disclose the method wherein said benefit of highest value to said user is obtained from the combination of a plurality of said categorized benefits. However, Walker discloses the method wherein said benefit of highest value to said user is obtained from the combination of a plurality of said categorized benefits (column 4, lines 34-40; column 10, lines 13-21; column 11, lines 3-20). It would be obvious to one of ordinary skill in the art to modify the card selection method as disclosed by Lalonde to adapt the teaching of applying a combination of benefits in order to obtain the highest value to a user as disclosed by Walker. The motivation would be that given a user has a plurality of cards, options yielding the highest return may include a combination of promotions or offers and the most effective system would provide the means by which a user would "cash in" all available options, such as the use of a manufactures coupon as well as "double" or "triple" coupons offered by a particular store, such that value would be maximized using all available options.

Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde. Lalonde does not specifically disclose the method further comprising the additional steps of aggregating requests received from a plurality of identified users and of

operating on such aggregated requests to effect an enhancement in the potential value of at least one of said identified benefits to at least one of said identified users.

However, Examiner takes Official Notice that it is old and well known for companies and organizations to hear customers' requests and to consider modifications to policies and procedures of all varieties in response to said requests, the motivation being that in the name of good will and customer service, companies and organizations are willing to hear, and respond if possible, to customer requests, particularly when the same request is received from a number of sources. It shows a consensus amongst customers that a policy or procedure of some sort should be modified.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

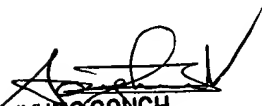
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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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